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10/018,952	04/18/2002	Peter Brune	RBL0084	6010

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EXAMINER

PEREZ, JULIO R

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 06/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,952

Applicant(s)

BRUNE ET AL.

Examiner

Julio R Perez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 5-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 5-6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *cannot depend from any other multiple dependent claim*. See MPEP § 608.01(n). Accordingly, the claims 5 and 6 have not been further treated on the merits.
2. Claims 3 and 4 are objected to because of the following informalities: According to the amendment dated 12/21/01, the entries corrections were not entered as "or 2" did not exist on claim 3, line 1 as called for. Further, the entry "one of claims 2 or 3" did not exist on claim 4, line 1 as called for. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 3,7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Rahman et al. (6036090).

Regarding claim 1, Rahman et al. teach a method for the simplified access to a telecommunication network and the billing of telecommunication services, characterized in that in the telecommunication network authentication processes are used which make it possible for the subscriber to ascertain at any freely choosable point in time that a payment is being made for the service requested or to be requested, or has already been made (col. 2, lines 64-67; col. 3, lines 1-9 and 35-40, the mobile terminal is authenticated before it is provided with any services; therein, assuring the mobile holds enough funds to access the network for service).

Regarding claim 2, Rahman et al. teach a method, characterized in that an authentication process is used by means of which the identity of the subscriber using services in the telecommunication network is established by at least one of the following measures: by a digital signature; directly over existing dependable mechanisms (EC card, electronic exchange) by technical proof beyond doubt of the association of the subscriber with a dependable third party which takes responsibility for the payment (credit organization), (col. 3, lines 35- 59, the subscriber is authenticated before services are rendered via a payment though a credit card or debit card).

Regarding claim 3, Rahman et al. teach a method, characterized in that the authentication and registration of the subscriber and the billing of the requested service,

occur by means of a credit card (col. 3, lines 51-57, the authentication and payment procedure may be performed via a credit card payment approval).

Regarding claim 7, Rahman et al. teach a device for simplified access to a telecommunication network and for the billing of telecommunication services, characterized in that the devices are present by means of which a subscriber can prove to the network operator in time context with an electronic payment process that a payment is being made, or has already been made for services requested or to be requested (col. 2, lines 64-67; col. 3, lines 1-9 and 49-65, the system provides the means to authentication of the mobile terminal prior to providing services; furthermore, the system requires the terminal to provide assurance through the credit card payment).

Regarding claim 8, Rahman et al. teach a method, characterized in that an authentication process is used by means of which the identify of the subscriber using services in the telecommunication network is established by at least one of the following measures: by digital signature; directly over existing dependable mechanisms, such as EC card, electronic market; by technical proof beyond doubt of the association of the subscriber with a dependable third party which takes responsibility for the payment, such as a credit card organization (col. 3, lines 35-59; col. 4, lines 32-38, the subscriber is authenticated before services are rendered via a payment though a credit card or debit card) .

Regarding claim 9, Rahman et al. teach a method, characterized in that the special subscriber identification module (9) and the special homeland register (10) have at their disposal restricted functionalities with respect to a regularly used subscriber

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identification module (2) and homeland register HLR (7) (col. 2, lines 64-67; col. 3, lines 1-21 and 35-48, the system strongly suggests the use of GSM scheme, whose identification of a mobile subscriber is inherently based on the SIM card. Moreover, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that subscriber data is stored in the home location register, which in fact contains an associated authentication center; this center has the subscriber authentication data and authentication algorithms; further it is inherent that a visitor location register within the system stores data of a visiting subscriber via the data received from the GSM mobile; GSM-based cell phones work with a small card containing an electronic chip called a Subscriber Identity Module card. The SIM card inserts into the cellular phone and contains information that is used to identify subscribers and their account information to the network. The SIM card must be inserted into a GSM Mobile handset to obtain access to the network).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rahman et al. (6036090).

Regarding claim 4, Rahman et al. teach the limitations in claims 1 and 2.

Rahman et al. do not explicitly disclose the process, characterized in that application of the subscriber to the telecommunication network occurs with the aid of a special subscriber identity module (Simple-SIM).

However, Rahman et al. strongly suggest the use of the system based on GSM, which inherently carries SIM means (col. 2, lines 48-67; col. 5, lines 4-19).

Therefore, it would have obvious to one of ordinary skill in the art at the time the invention was made to implement the system as taught by Rahman et al. with a GSM terminal, which incorporates a subscriber identity module (SIM card) in order to access the wireless network with the security and authentication schemes provided by the GSM SIM card.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the art with respect to automated prepayment method, registrations procedures, and identification modules network with debt accounts.


US patent No. 5748720 to Loder	Subscriber identification module from a radio terminal
US patent No. 5592535 to Klotz	Radio network with debt accounts
US patent No. 6067529 to Ray et al.	Message containing purchase information to a destination terminal
US patent No. 6047051 to Ginzboorg et al.	Charging in a telecommunication system
US patent No. 6587880 to Saigo et al.	Management system and management method
US patent No. 6226364 to O'Neil	Providing prepaid and credit limited phone service
US patent No. 5537474 to Brown et al.	Authentication in a communication system
US patent No. 6516193 to Salmela et al.	Services in a mobile system

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R Perez whose telephone number is (703) 305-8637. The examiner can normally be reached on Monday - Friday, 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JP
6/21/04


ERIKA GARY
PATENT EXAMINER